

### REMARKS

Claims 1-9, 11-23, 25-30 and 32-46 are currently pending in this application. By this Response, Applicant has amended claim 16 in order to correct a typographical error. No new matter has been added by this amendment. Accordingly, claims 1-9, 11-23, 25-30 and 32-46 are at issue.

The Examiner has rejected claims 3, 19 and 33 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, reasoning that the specification lacks written descriptive support for the phrase “wherein the programming device is resident within the factory automation controller.” Applicant respectfully traverses this rejection.

The specification states at paragraph 24 that “[t]he web site 4 contains the application program 22 for operating the PLC 32 and the programming device 21 for editing the application program 22.” Paragraph 33 of the specification further discloses that “Figure 5 shows an alternative configuration wherein *some or all of the components of the web site 4 reside on the PLC.*” (Emphasis added). As disclosed in the specification at paragraph 23, the factory automation device is “preferably a PLC 32.” Therefore, the specification supports the phrase “wherein the programming device is resident within the factory automation controller” and the enablement requirement has been met.

The Examiner has rejected claims 1-3, 5-9, 11-13, 17-20, 22-23, 25-26, 30, 32-33 and 35-43 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,788,980 (“Johnson”). Applicant respectfully traverses this rejection.

In order for a reference to constitute a §102 bar to patentability, the reference must disclose each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983).

The Johnson reference cited by the Examiner does not disclose each and every element of claims 1, 3, 6 and 8. In particular, Johnson does not disclose “a program package embedded in the programming device, the program package for creating and editing the application program” as required by each of claims 1, 3, 6 and 8.

The Examiner cites to column 8, lines 3-8 of Johnson in support of the rejection of claims 1, 3, 6 and 8. However, in contrast to the claimed invention, column 8, lines 3-8 of Johnson

discloses the use of configurator software, “permitting each device to configure the control system or selected portions of it.” In other words, the configurator software allows the user to turn on available options and turn off others as desired, i.e., to configure the system. This meaning is confirmed by the next sentence in Johnson: “[t]hose skilled in the art will appreciate that not all of these components need be included in all native control devices, e.g., some commercially available JVMs can serve as an OS themselves.” See Johnson at col. 8, lines 5-8. In other words, one skilled in the art would understand that the configuration will depend on the particular system or device.

Claims 1, 3, 6 and 8 each call for “a program package embedded in the programming device, the program package *for creating and editing the application program*.” The configurator software of Johnson does not create and edit the application program. Applicant’s invention goes beyond having the ability to turn *available* options on and off. Applicant’s invention allows the user “to view, create and edit the PLC application programs 22 from anywhere a browser 10 is available.” See Application at paragraph 31. As expressly set forth in the Application,

“[t]he information needed to edit the operating program, including web pages for the editing procedures, resides in the programming device 21, preferably the program package 33. The program package 33 converts the PLC operating programs to and from formats needed for editing with a browser 10.”

See Application at paragraph 31. Therefore, Applicant respectfully submits claims 1, 3, 6 and 8 are not anticipated by Johnson and requests that the rejection of these claims under 35 U.S.C. 102(e) be removed.

As claims 2, 5, 7, 9 and 11-13 depend upon claim 1 and contain all of the limitations thereof, Applicant respectfully submits these claims are also novel in view of Johnson.

Claims 17, 19 and 23 each require a “means for editing the application program resident in a programming device.” As noted above, Johnson does not disclose, teach or suggest a means for editing the application program resident in a programming device. Rather, as noted above, Johnson discusses configurator software for configuring a control system. Therefore, Applicant respectfully submits claims 17, 19 and 23 are not anticipated by Johnson for the same reasons

that claims 1, 3, 6 and 8 are not anticipated by Johnson and requests that the rejection of these claims under 35 U.S.C. 102(e) be removed.

As claims 18, 20, 22 and 25-26 depend upon claim 17 and contain all of the limitations thereof, Applicant respectfully submits these claims are also novel in view of Johnson.

Claims 30, 33 and 36 are method claims, each of which require the step of "editing the application program via a program package resident in the programming device." As noted above, Johnson does not disclose, teach or suggest editing the application program via a program package resident in the programming device. Rather, as noted above, Johnson discusses configurator software for configuring a control system. Moreover, while an apparatus claim can be anticipated by a prior device that is similarly constructed and capable of performing the same function, such is not the case with a method claim. *See Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 424 (1902). It is not enough that a prior device *could* be used to practice the claimed method. *See, e.g., Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1309 (Fed. Cir. 2004) (method claim not invalidated by prior device later asserted to be usable in the claimed method). Instead, the prior device anticipates only if it performs the claimed method in its normal and usual operation. *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986). As there is no mention of editing capability with regard to the application program in Johnson, it can hardly be said that the device of Johnson performs the invention of claims 30, 33 and 36 in its normal and usual operation. Therefore, Applicant respectfully submits claims 30, 33 and 36 are not anticipated by Johnson and requests that the rejection of these claims under 35 U.S.C. 102(e) be removed.

As claims 32, 35, and 37-43 depend upon claim 30 and contain all of the limitations thereof, Applicant respectfully submits these claims are also novel in view of Johnson.

The Examiner has rejected claims 4, 14-15, 21, 27-28, 34, and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of U.S. Patent No. 6,038,486 ("Saitoh"). Applicant respectfully traverses this rejection.

Initially, Applicant points out that claims 4, 14-15, 21, 27-28, 34, and 44-45 depend upon claims 1, 17 and 30, respectively, and contain all of the limitations thereof. Therefore, Applicant respectfully submits that claims 4, 14-15, 21, 27-28, 34, and 44-45 are allowable in view of the above remarks respecting the independent claims.

Moreover, the addition of Saitoh does nothing to cure the deficiency of Johnson discussed above. In fact, the Examiner points to no such disclosure in Saitoh. The law is settled that to establish a prima facie case of obviousness, all of the elements of the claimed invention must be disclosed, taught, or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). This burden has not been met. Additionally, the Examiner has failed to meet his burden of showing any incentive or motivation in the prior art to combine the references in the manner proposed. Therefore, Applicant respectfully submits that claims 4, 14-15, 21, 27-28, 34, and 44-45 are in condition for allowance.

Application No. 09/635,278  
Attorney Docket No. SAA-34-1 (402 P 229)  
Reply to November 24, 2004 Non-Final Office Action

**CONCLUSION**

Applicant requests reconsideration and allowance of claims 1-9, 11-23, 25-30 and 32-46. Applicant notes that claims 16, 29 and 46 have been allowed. Accordingly, Applicant respectfully submits that all pending claims are now in condition for allowance. Applicant invites the Examiner to contact the undersigned representative at the telephone number below to discuss any matters pertaining to the present Application.

Respectfully submitted,

Dated: February 23, 2005

By:



Richard C. Himelhoch, Reg. No. 35,544  
Wallenstein Wagner & Rockey, Ltd.  
311 South Wacker Drive, 53<sup>rd</sup> Floor  
Chicago, Illinois 60606-6630  
312.554.3300

---

**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Mail Stop Amendment, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 23, 2005.



Natalie L. Kurowski/216681.1